

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested. Claims 8-14 are pending. In the outstanding Office Action, Claims 8-10 were rejected under 35 U.S.C. § 103 as unpatentable over Haghiri-Tehrani in view of Fjelstad, and Claims 11-14 were allowed. Applicant respectfully traverses the rejection of Claims 8-10.

With respect to the rejection of Claims 8-10, it is first noted that, in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Independent Claim 8 defines the step of forming a plurality of sets of die bond pads and wire bond pads by fastening electrically conductive metal sheets at specified positions on the back of an insulating sheet and making apertures on the insulating sheet on the metal sheets. This feature is simply not taught in either the Haghiri-Tehrani reference or in the Fjelstad reference.

Haghiri-Tehrani discloses several ways that an insulating layer 11 bearing a contact layout can be produced, at column 3, line 52, to column 4, line 5. Even if the contact layout with contact surfaces 15 to 20 and a bar 26, shown in Figure 2 for example, can properly be considered analogous to the die bond pads and wire bond pads defined by Claim 8, nothing in Haghiri-Tehrani teaches or suggests forming a plurality of sets of die bond pads and wire bond pads by fastening electrically conductive metal sheets at specified positions on the back of an insulating sheet and making apertures in the insulating sheets on the metal sheets. The phrase "metal sheets" is plural in the claim, meaning that more than one electrically conductive metal sheet must be fastened on the back of the insulating sheet. Haghiri-Tehrani merely discloses the use of an all-over conductive coating or a perforated metal band.

Accordingly, Haghiri-Tehrani is not believed to anticipate or make obvious the invention of Claim 8. Nor is this feature disclosed by the Fjelstad reference. Thus, the Haghiri-Tehrani and Fjelstad references, when considered alone or in any proper combination, are not believed to anticipate or make obvious the invention of Claim 8.

Further, prior art cannot be modified or combined to reject claims as *prima facie* obvious when there is no reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir 1986). Even then, the mere fact that references *can* be combined does not render the resultant combination obvious unless the prior art also teaches the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Haghiri-Tehrani reference relates to a method of producing an ID card. Col. 3, line 15. A casting compound 38 is supplied only in the recess of the circuit on the card, as shown in Figures 6-9 and described at column 5, lines 24-26. One of ordinary skill in the art would not be motivated to supply a casting compound or a resin over the entire surface of the card because it would unnecessarily increase the thickness of the card, which would defeat one of the goals of the Haghiri-Tehrani reference, which is to minimize the height of the module. Col. 5, lines 25-26. It also might make it difficult, if not impossible, to include certain types of information (such as print or a photograph) on the side of the card containing the casting compound. Moreover, if the casting compound were used outside of the recesses, the cost of the card would be increased. On the other hand, the invention of Claim 8 defines the step of sealing the plurality of discrete semiconductor elements installed on the insulating sheet with an integral sealing resin by sealing the packaging surface of the insulating sheet with the resin. Even if this feature were taught by Fjelstad, it would not be *obvious* to one of ordinary skill in the art to modify Haghiri-Tehrani to include it. Accordingly, it is only through improper hindsight reasoning by which the Haghiri-Tehrani and Fjelstad references could be combined, if at all.

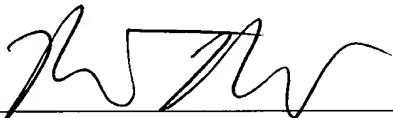
Therefore, Applicants submit that independent Claim 8 patentably distinguishes over the applied references. Since Claims 9 and 10 depend from Claim 8, Applicant also submits that Claims 9 and 10 patentably distinguish over the applied references for at least the same reasons as Claim 8.

In view of the foregoing discussion, no further issues are believed to be outstanding in the present application. Therefore, Applicant respectfully requests that the present application be allowed and be passed to issue.

Respectfully submitted,

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